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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/603,279

06/25/2003

Lee Michael Teras

9286

4437

27752

7590

09/02/2008

THE PROCTER & GAMBLE COMPANY

Global Legal Department - IP

Sycamore Building - 4th Floor

299 East Sixth Street

CINCINNATI, OH 45202

EXAMINER

THAKUR, VIREN A

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

09/02/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/603,279

Applicant(s)

TERAS ET AL.

Examiner

VIREN THAKUR

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5 and 10-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3,5 and 10-15 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 15, 2008 has been entered.

Double Patenting

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claim 10 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 53 of copending Application No. 10/606137. This is a provisional double patenting rejection since the conflicting claims have not in fact been

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patented. It is noted that claim 53 covers the same scope as that of claim 10 of the instant application. That is, claim 53 discloses using a corn-based food material to which is added asparaginase for the purpose of removing asparagine or converting asparagine to a different substance and heating the food. Claim 51 discloses providing the food material and adding asparaginase to the food material and heating the food material to form a food product. Therefore the scope of copending claim 53 is the same as that of claim 10 of the instant application.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. The Examiner notes that in the previously mailed remarks, Applicant has indicated that at the time of the final disposition of the pending claims is determined appropriate Terminal Disclaimers can be filed. The Examiner asserts however that until

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a Terminal Disclaimer is filed the rejections remain pending and thus have been maintained for the reasons of record.

6. Claims 1-5 and 10-15 remain provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-32 and 42-50 of copending Application No. 10/606137, for the reasons given in the previous Office Action, mailed June 30, 2004

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 11-15 remain rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6989167, for the reasons given in the previous Office Action, mailed June 30, 2004.

This rejection had previously been made over claims 1-14 of copending Application No. 10/603978, which has now been issued as U.S. Patent No. 6989167. Nevertheless, the rejection is taken as previously cited under the provisional double patenting rejection of record.

8. Claims 11-15 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 64-70 of copending Application No. 11/090570.

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Although the conflicting claims are not identical they are not patentably distinct from each other because claims 64-70 encompass the limitations of claims 11-15 of the instant application.

That is, copending claims 64 and 65 teach a reduction of 10 percent of the acrylamide level but claims 66-70 disclose a range of levels of acrylamide. Each of claims 66-70 disclose wherein the food product comprises "less than about" a particular level of acrylamide, which also includes levels such as 1 ppb acrylamide. Nevertheless, to reduce the amount of acrylamide by a particular amount by using an asparagine reducing enzyme would also inherently have reduced the amount of asparagine present. To therefore reduce the amount of asparagine by a particular amount would thus have been an obvious matter of routine determination, once it was known to use an asparagine reducing enzyme to reduce the amount of asparagine in the food material.

Allowable Subject Matter

9. The following is a statement of reasons for the indication of allowable subject matter: the closest prior art, Elder et al.(US 20040058054) has been overcome by the filing of the declaration by Teras et al. on May 15, 2008 and in light of the cancellation of claims 1-13 of the subsequently issued patent to Elder et al. (US 7037540) as a result of the judgment by the Board of Patent Appeals and Interferences that Zyzak et al. "was both first to conceive and first to reduce to practice the subject matter of the count" and

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that "priority of invention lies with" Zyzak et al. Furthermore, it is noted that food products comprised of corn are claimed in claim 53 of Application No. 10/606137.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VIREN THAKUR whose telephone number is (571)272-6694. The examiner can normally be reached on Monday through Friday from 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571)272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. T./

Examiner, Art Unit 1794


KEITH D. HENDRICKS
SUPERVISORY PATENT EXAMINER